



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,921	03/10/2004	Richard Dick	10752.9	6824
21999	7590	07/25/2007		
KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111			EXAMINER SHIFERAW, ELENIA	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,921

Applicant(s)

DICK, RICHARD

Examiner

Eleni A. Shiferaw

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/11/07
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-13 are pending and presented for examination.

Claim Objections

2. Claim 1 is objected to because of the following informalities: In line 1 of claim 1 discloses “the release of personal information”. Since there is no “release of personal information” to refer to before that line, it is suggested that it should be changed to “a release of personal information”. Appropriate correction is required.

- 2.1 Claim 1 is objected to because of the following informalities: In line 4 the claim recites “personal information”. The examiner thinks applicant is trying to refer to the same “personal information” as in line 2 and suggests that it should be changed to “said some personal information”. Appropriate correction is required.

- 2.2 Claim 6 is objected to because of the following informalities: Line 2 of claim 6 recites “a database service”. The examiner thinks the applicant is trying to refer to the same “database service” as recited in claim 4 line 1, and suggests that it should be changed to “said database service”. Appropriate correction is required.

- 2.3 Claim 7 is objected to because of the following informalities: Line 9 of claim 7 recites “a wide area computer network”. The examiner thinks the applicant is trying to refer to “wide area

Art Unit: 2136

computer network” of line 4 and 7, and suggests that it should be changed to “said wide area computer network”. Appropriate correction is required.

2.4 Claim 7 is objected to because of the following informalities: Line 8 of claim 7 discloses “a database”. The examiner thinks that the applicant is trying to refer to the same “database” in line 1, and suggests that the word should be changed to “said database”. Appropriate correction is required.

2.5 Claim 7 is objected to because of the following informalities: Line 14 of claim 7 discloses “commentary”. The examiner thinks that the applicant is trying to refer to “commentary” of line 6 and 8, and suggests that the word should be changed to “said commentary”. Appropriate correction is required.

2.6 Claim 8 is objected to because of the following informalities: The end of the limitation recites “the Internet”. Since there is no Internet recited before that line, it is suggested that it is changed to “Internet” or “an Internet”. Appropriate correction is required.

2.7 Claim 12 is objected to because of the following informalities: The end of the limitation recites “a database service”. The examiner thinks that the applicant is trying to refer to the same “database service” as claim 10, and suggests that it is changed to “said database service”.

Appropriate correction is required.

Art Unit: 2136

2.8 Claim 13 is objected to because of the following informalities: The end of the limitation recites "a database service". The examiner thinks that the applicant is trying to refer to the same "database service" as claim 10 and 12, and suggests that it is changed to "said database service". Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,804,787. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1-13 correspond to the claims 1-19 of the patent claims and encompass the scope of claims 1-13 of the instant application.

The instant application generally claims a method for controlling a release of personal

Art Unit: 2136

information. Patent 6,804,787 claims similar limitations except “health information”, “a requester”, “patient”, “a single point entry/exit”, and “request electronically authenticated to be authorized by the patient”. However the instant application claims equivalent words/limitations: “personal information”, “organizations”, “individual”, “enterprise/server”, and “to not release information ... without receiving authorization from said individual”, respectively. They are equivalent because in the instant application page 19 lines 4 discloses personal information including medical records. Page 19 paragraph 3-page 20 paragraph 2 discloses a requester being a medical organization. Fig. 2 discloses a user 100 that is patient to medical organizations 106 and/or third party insurance company 112. On page 20 paragraph 1, disclosed each of the organization contractually agrees to first contact enterprise/server 102 before releasing any information about the user so the server 102 can inform and request the user 100 if request to release confidential information is acceptable or not. On page 10 paragraph 2 the instant application discloses member/user/patient receiving an electronic alert, such as email, when information about the member is accessed or requested and on page 20 paragraph 1 disclosed when confidential information request is received the user must be contacted before releasing access.

Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitation of the instant application. Claims of the instant application therefore are not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting (*In re Goodman (CAFC) 29 USPQ2D 2010 (13/3/1993)*).

Art Unit: 2136

4. Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-24 of copending Application No. 11057097. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1-13 correspond to the claims of the copending claims and encompass the scope of claims 1-13 of the instant application. The instant application generally claims a method for controlling a release of personal information. Copending application 11057097 claims similar limitations except "if the requested information is not subject to the requirement, releasing the requested information to the requestor". However, Copending application claims, "determining whether the consent of the individual has been obtained, wherein the releasing of the requested information to the requestor is performed ...if the consent of the individual has been obtained when the consent is required", which is equivalent to the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim5 Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1 Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Shelton USPN 7,028,049 B1 in view of Coleman PG Pub 2004/0139025 A1.

Art Unit: 2136

Regarding claim 1, Shelton discloses a method for controlling the release of personal information (col. 4 lines 53-58, col. 8 lines 1-4, col. 3 lines 44-col. 4 lines 24 and col. 16 lines 32-63; *controlling release of patient's confidential medical records by requiring patient's authorization anytime access is requested*) comprising:

depositing some personal information regarding an individual with an enterprise/server (col. 3 lines 66-col. 4 lines 2, col. 9 lines 40-45, col. 5 lines 1-9 and fig. 1 elements 13 and 21; *plurality of patients medical data stored in a database*);

organizations (col. 9 lines 9-18, col. 9 lines 57-63, and fig. 1 elements 10a-c; *health care info. users are clients 10a-c, hospitals, doctors, nursing services, insurance companies...*) possess personal information regarding said individual to not disclose that information without authorization from said enterprise/server (col. 7 lines 40-50, col. 10 lines 18-36, col. 9 lines 1-8, and col. 10 lines 53-col. 11 lines 45; *physicians/insurance companies 10b requiring patients confidential info. to be shared with authorized third-parties and server 12/approval agent 16 requesting patient's approval first... no medical document of the patient's is provided without patient's consent*); and

instructing said enterprise/server to not release information held on the enterprise/server and at the organizations without receiving authorization from said individual (col. 11 lines 32-45, col. 8 lines 1-4; *server 12/approval agent 16 is instructed not to release any patient's medical records stored in the database 21 and indexed in a master index 13 without first requesting patient's approval for release*).

Art Unit: 2136

Shelton is silent about **obligating** organizations that possess personal information regarding said individual to not disclose that information without authorization from said enterprise/server. However, **Coleman** discloses a method of controlling and/or protecting the privacy of individuals' personal information (see abstract and fig. 2 element 420; *protecting personal medical record*) by obligating (col. 0041) entities (*merchant, insurance companies*, see par. 0030) to protect individuals' personal information (0056-0059 and fig. 3) and providing individual generated restrictive notice to obligate entities (par. 0031, 0056-0059), wherein said protect including obligation to entities not to share, transfer, and sell personal information to other entities (par. 0027, 0059, and 0061).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Coleman within the system of Shelton because they are analogous in protecting personal confidential data. One would have been motivated to incorporate the teachings, of obligating organizations/entities not to disclose individuals' confidential data, because it would restrict the organization/entities from sharing or transferring individuals confidential information without individual's permission.

Regarding claim 2, Shelton discloses the method, wherein said enterprise/server is Internet-accessible (col. 9 lines 19-32 and lines 41-45).

Regarding claim 3, Shelton discloses the method, further comprising using WebCrawler programs to locate and retrieve information regarding said individual (col. 16 lines 64-col. 17 lines 12; *web robot*).

Regarding claim 4, Shelton discloses the method wherein said individual is a member of a database service (col. 3 lines 66-col. 4 lines 2, col. 9 lines 40-45, col. 5 lines 1-9 and fig. 1 elements 13 and 21).

Regarding claim 5, Shelton discloses the method wherein said personal information comprises database entries (col. 3 lines 66-col. 4 lines 2, and fig. 1 elements 13 and 21).

Regarding claim 6, Shelton discloses the method wherein said obligated organizations are subscribers to a database service (col. 9 lines 57-col. 10 lines 4 and col. 5 lines 33-35).

5.2 Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton USPN 7,028,049 B1 in view of Adams et al. PG Pubs 2002/0013519 A1.

Regarding claim 7, Shelton discloses a method for creating a database of verified personal information (col. 4 lines 53-58, col. 8 lines 1-4, col. 3 lines 44-col. 4 lines 24 and col. 16 lines 32-63; *controlling release of patient's confidential medical records of database 21/master index 13 by requiring patient's verifying anytime access is requested*) comprising:

gathering information regarding an individual (*patient*) (col. 3 lines 66-col. 4 lines 2, col. 9 lines 40-45, col. 5 lines 1-9 and fig. 1 elements 13 and 21; *plurality of patients medical data stored in a database*);

Art Unit: 2136

receiving a request over a wide area computer network (WAN see col. 9 lines 1-8) from an authorized individual (*physicians/insurance companies 10b*) to review selected portions of said information (col. 9 lines 57-col. 10 lines 36, and col. 10 lines 53-col. 11 lines 45; *physicians/insurance companies 10b requesting patients confidential info.*);

presenting said request to said individual (*patient*) for authorization (col. 11 lines 31-45, col. 8 lines 1-4, and col. 10 lines 53-col. 11 lines 20; *server 12/approval agent 16 indicating/presenting that a request has been made for the records selected by the requesting client 10 to the patient for authorization*);

presenting said selected portions (*patient history, comprehensive medical records, lab reports, test results, prescription drug records... see col. 7 lines 5-12*) of said information over said wide area computer network to said authorized individual (*physicians/insurance companies 10b*) (col. 16 lines 32-63, col. 11 lines 4-53, col. 10 lines 18-35, and col. 7 lines 40-50); and providing access to said database and commentary (*patient consent/evidentiary documentation of the propriety*) to third parties (*insurance company/other doctor*) (col. 7 lines 40-50, col. 6 lines 12-15, and col. 16 lines 32-63).

Shelton discloses presenting request to patients' medical record by email/fax. Shelton is silent regarding presenting said information over a wide area computer network to said individual (*patient*) to review and verify said information's accuracy; accepting commentary on the accuracy of said information based on said review from said individual over the wide area computer network; and including said commentary in a database with said information.

However Adams et al. discloses a secure patient test result delivery system (see abstract). Patient is presented information over a wide area computer network (par. 0015-0016) to review

Art Unit: 2136

and verify and information's accuracy (par. 0085, 0095, 0109; *patient logging online and editing patient database 560, that contain name, unique ID, phone number, address..., and editing to allow release of her/his information to physicians*); patient accepting commentary (*checking release box*) on the accuracy of said information based on said review from said individual over the wide area computer network (par. 0118; *patient checking a medical release box via network for review by physicians*) and including said commentary in a database with said information (0085, 0095, 0109 and 0118).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Adams et al. within the system of Shelton because they are analogous in patient medical data protection by requiring patients approval. One would have been motivated to do so because a patient would review and verify his/her information for editing/upgrading current info. and allowing or denying access to physicians.

Regarding claim 8, Shelton discloses the method wherein said wide area computer network is the Internet (col. 9 lines 19-32 and lines 41-45).

Regarding claim 9, Shelton discloses the method, wherein said the step of gathering information further comprises using WebCrawler programs to locate and retrieve information regarding individuals (col. 16 lines 64-col. 17 lines 12; *web robot*).

Regarding claim 10, Shelton discloses the method wherein said individual is a member of a database service (Shelton col. 3 lines 66-col. 4 lines 2, col. 9 lines 40-45, col. 5 lines 1-9 and fig.

Art Unit: 2136

1 elements 13 and 21).

Regarding claim 11, Shelton discloses the method wherein said selected portions of said information and said information are database entries related to said individual (col. 13 lines 41-col. 14 lines 10, col. 10 lines 6-11, and fig. 1 element 21; *indexing and/or storing patient medical record.... Social security number, and name*).

Regarding claim 12, Shelton discloses the method wherein said third parties are subscribers to a database service (col. 7 lines 40-50).

Regarding claim 13, Shelton discloses the method wherein said authorized individuals are members of a database service (col. 9 lines 57-col. 10 lines 4 and col. 5 lines 33-35).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867.

The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser R. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 2136

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ES

July 3, 2007

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100


7,23,07